

Bankstahl, Herbert A.

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REMARKS

The present application contains claims 1-109. In the Final Office Action mailed May 9, 2006, the Examiner rejected claims 1-4, 6-7, 11-12 and 14-15 under 35 U.S.C. §102(b) as being anticipated by Stevens, Jr. et al. (USP 2,742,622). The Examiner next rejected claims 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Stevens, Jr. et al. in view of Double et al. (USP 3,736,548). Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Stevens, Jr. et al. in view of Double et al. as applied in claim 1 above, and further in view of Cusick et al. (EP 241,121) (equivalent Cusick, III et al. USP 4,702,539). Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Stevens, Jr. et al. in view of Double et al. as applied in claim 1 above, and further in view of Lecocq et al. (USP 3,491,329). Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Stevens, Jr. et al. in view of Double et al. as applied in claim 11 above, and further in view of Cusick et al. Claims 106-108 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lecocq et al. in view of Stevens, Jr. et al.

The Examiner objected to the drawings stating that "the subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention" and that "Applicant is required to furnish the drawings for species 3-8." *Office Action, May 9, 2006, p. 3.* The Examiner's requirement demonstrates apparent disregard to the Applicant's remarks in the Responses of September 12, 2005 and February 23, 2006 that "claims are never species" as stated in MPEP §806.04(e). Additionally, the Examiner requires Applicant to submit drawings for matter that is already shown in the pending drawings and for claims the Examiner has withdrawn from consideration. However, that which is called for in all of the originally filed claims is indeed shown in the drawings as originally filed.

With regard to the restriction requirement, the Examiner has failed to satisfy the burden required for a species restriction and hereby requests reconsideration. As stated in MPEP §806.04(b), species can be either independent or distinct. For independent species, the Examiner must show that "species under a claimed genus are not connected in any of design, operation, or effect." *MPEP §806.04(b)*. The Examiner has failed to show that the species are not connected in any of design, operation, or effect. The Examiner merely concluded that the species were patentably distinct based on non-material differences in the individual words of the claims identified as species 2 and the claims cited for each of the other alleged species. *See Office Action, May 9, 2006, p. 2.* This alone does not show that the Examiner's identified species are independent because a restriction requirement must be based on claim elements, not simply

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preamble language. Thus, the Examiner has not met the burden under MPEP §806.04(b) to show independent species.

Furthermore, Applicant believes the Examiner cannot show distinctness of any of the species with respect to one another. Specifically, for the Examiner to show that inventions are related as disclosed and distinct as claimed, "the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05 – §806.05(j)." *MPEP §806.04(b)*. The Examiner made no attempt to show that the species are distinct under any section of MPEP §806.05 – §806.05(j). Additionally, the Examiner "must explain why there would be a serious burden on the examiner if restriction is not required." *MPEP §808.02*. The Examiner may show a serious burden by separate classification, separate status in the art, or a different field of search. *See Id.* The Examiner failed to show any separate classification, any separate status in the art, or any different field of search. Thus, the Examiner has not met the requirements as set forth by MPEP §806.04(b) and MPEP §808.02. Applicant requests reconsideration of the restriction requirement.

Additionally, the Examiner restricted species 8, claims 85-105 and 109 because "species 2 does not have the torch." *Office Action, May 9, 2006, p. 3*. Although the Examiner included claim 109 in species 8, claim 109 depends from claim 106, which the Examiner included in species 2. Applicant is confused with the Examiner's inclusion of claim 109 in the "species" identified by the Examiner as pertaining to claims 85-105, followed by the statement that species 2 does not have a torch. In the Office Action dated November 23, 2005, Examiner stated that the restriction of species 8 (claims 85-105 and 109) was based on the fact that "species 2 does not have the stud." *Office Action, Nov. 23, 2005, p. 3*. Applicant responded that claim 109 does not call for a stud. In the Office Action dated May 9, 2005, Examiner responded to Applicant's remarks, stating that "the review of the first action (11/23/05) indicated that Claim 109 was discussed in section 2 as not having a stud. The traversal of Species was never relied on a stud. That is a torch. This is just a typo error." *Office Action, May 9, 2006, p. 11*. If the Examiner defines species 8 as including a torch, the inclusion of claims 85-105 in species 8 is improper as claims 85-105 do not mention "torch." Furthermore, as stated above, the Examiner has failed to address any of the elements required to satisfy the burden required in making any restriction requirement, let alone a species restriction. As such, the restriction requirement in the Final Office Action mailed May 9, 2006 is improper and withdrawal thereof is respectfully requested.

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With respect to the rejection of claim 1, the Examiner rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Stevens. The Examiner stated, "Stevens discloses the high-power quick connector assembly . . . [having] a recess (formed inside 62) constructed to receive the stem portion (30) of the first connector (12) and engage the shank segment (a portion of 30) and the threaded segment (a portion of 40, 42) (figure 1)." *Office Action, May 9, 2006, p. 4.* Applicant respectfully disagrees.

Stevens shows engagement of threaded segment (40 and 42) in Figure 3. However, claim 1 calls for engagement of two distinct elements of the stem portion of the first connector: a shank segment and a threaded segment. Stevens does not show engagement of any separate shank segment in the recess (62). While Stevens may teach "coupling being completed by the threading or rotary movement at the end of the inserting movement" of the male element into the female element (*Col. 1, lines 45-52*), such coupling only involves the threaded portion of 30 (threaded segments (40 and 42)) and no other "portion of 30," which the Examiner failed to identify with any particularity.

The Examiner further stated that Stevens discloses a high-power quick connector assembly. Claim 1 calls for the first connector to be connectable to a welding cable. While Stevens may teach a cable connector, Stevens does not disclose connecting either connector section 12 or 14 to a welding cable. In fact, the words "weld" or "welding" never appear in Stevens.

Accordingly, that which is called for in claim 1 is not shown or disclosed in Stevens. While claims 2-15 are in condition for allowance at least pursuant to the chain of dependency, dependant claims 2-15 include additional subject matter that is distinguishable from the art of record. Therefore, at least some of these additional distinctions will be addressed in detail.

The Examiner rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Double and in further view of EP241121. The Examiner stated that "EP241121A2 teaches a threaded hole (adjacent to reference numeral 14) is formed in the collar portion of the first connector (18)(figure 1)." *Office Action, May 9, 2006, p. 7.* The Examiner further stated that "it would have been obvious to one having ordinary skill . . . to modify the connector assembly of Stevens by having a thread hole in the first connector body as taught by EP241121 for securing the collar of the first connector to the outer housing of the connector assembly." *Id.*

Claim 5 calls for a plurality of threaded holes formed in the collar portion of the first connector of the high-power quick connector assembly. While it appears EP241121A2 contains a

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threaded hole (adjacent to reference numeral 14), the threaded hole is part of the second connector (14), not the first connector (12). That is, claim 1 calls for the first connector to have a stem portion and a collar portion. The female connector 14 of EP241121, which the Examiner asserts as containing a threaded hole, does not have a stem portion having a shank segment and a threaded segment. EP241121 does not teach, and the Examiner has not shown, threaded holes in the male connector, let alone a plurality of threaded holes in the male connector. Therefore, EP241121 does not teach a threaded hole formed in the collar portion of the first connector as called for in claim 5.

The Examiner rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Double. The Examiner stated that "Double teaches a weld cable" and cited column 8, lines 7-8 of Double. *Office Action, May 9, 2006, p. 6*. Applicant respectfully disagrees.

Claim 8 calls for a connector attached to a welding cable. Double fails to teach or suggest a weld cable. Double discloses an electrical connector structure employed in connection with submersible pumps. Column 8, lines 7-12 of Double read, "[t]he potting material M is such that it welds with the cable casing and is such that when it is cured . . . it establishes an extremely strong, durable and fluid tight connection with and between the cable and the body." One skilled in the art would recognize that the use of the term "weld" in Double refers to the bond formed between the potting material and the cable casing, not to connecting the potting material to a weld cable. As such, Double fails to teach or suggest a connector attached to a weld cable.

The Examiner also rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Double. The Examiner stated that, while Stevens "lacks to disclose the level of temperature and the amount of flow current," it would have been obvious to "provide on the connector assembly of Stevens a temperature change of less than approximately 40 degrees when subjected to a current of approximately 700 amps to prevent overheating." *Office Action, May 9, 2006, p. 6*. Applicant respectfully disagrees.

The burden of establishing a prima facie case of obviousness falls on the Examiner. *MPEP §2143*. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner failed to show where either Stevens or Double teach the assembly to be constructed to maintain a temperature change of less than approximately 40 degrees when subjected to a current of approximately 700 amps. The Examiner merely concluded that such would be obvious to one skilled in the art without identifying where such is

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taught in the prior art. Therefore, notwithstanding the teachings of Stevens or Double, the art relied upon by the Examiner fails to teach or suggest that called for in claim 10. As such, Applicant believes that claim 10 is also patentably distinct from the art of record.

The Examiner rejected claim 106 under 35 U.S.C. 103(a) as being unpatentable over Lecocq in view of Stevens. Examiner asserts that it would be obvious to one having ordinary skill at the time the invention was made to "provide on the connector assembly of Lecocq the amount of copper such as 80% and brass materials such as 75%." *Office Action, May 9, 2006, p. 9*. Lecocq, however, does not specify the percentage of copper and brass to be used in the connectors. Lecocq only discloses the use of "conductive material such as tellurium copper or brass." *Col. 3, line 32*. Furthermore, Stevens only states that the coupling element be formed of "any suitable electronically conductive metal." *Col. 2, line 32*. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03. Furthermore, according to MPEP §2143.01, "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so." There is no teaching or suggestion in either Lecocq or Stevens to construct the connector from a material having an electrical conductivity of at least 80% of that of copper and having a machineability of at least 75% of that of brass as called for in claim 106. As such, all the claim limitations are not taught or suggested by the prior art. Accordingly, Applicant believes claim 106, and the claims that depend therefrom, are patentable over Lecocq and Stevens.

With respect to claim 107, the Examiner asserts that "it would have been obvious to one having ordinary skill at the time the invention was made to provide on the connector assembly of Lecocq the material having yield strength of at least 40 Kpsi for greater durability." *Office Action, May 9, 2006, p. 9*. Applicant respectfully disagrees.

Applicant again references *In re Royka* and MPEP § 2143.01, *supra*, which state that all the claim limitations must be taught or suggested by the prior art. The Examiner has not shown where the prior art teaches or suggests a material having a yield strength of at least 40 Kpsi. As such, each and every claim limitation is not taught or suggested by the prior art. Accordingly, that which is called for in claim 107 is patentable over Lecocq and Stevens.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-15 and 106-108.

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Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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¹The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2623. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2623. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2623.